

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-3, 5, 6, 8-11, and 13 in the reply filed on 9/21/09 is acknowledged. The traversal is on the ground(s) that the amendment to the claims requires the special technical feature of the same adhesive and a cross-linking agent wherein the amendment to the claims overcomes Mallik (U.S. Patent Application Publication 2003/0102080) which does not disclose cross-linked animal glue. This is not found persuasive. The previous restriction requirement set forth four groups: Group I, now claim(s) 1-3, 5, 6, 8-11, and 13 drawn to a process of applying a label, Group II, claim(s) 14 and 15 drawn to a labeled container, Group III, claim(s) 16 drawn to hydrophilic composition, and Group IV, claim(s) 17 drawn to an activating composition. Groups I-III were considered to require the same special technical feature of including animal glue which feature was known in the prior art as shown by Mallik and therefore, lack of unity exists between Groups I-III. Group IV was considered to lack unity with Groups I-III as they lack the same or corresponding special technical feature. In view of applicants amendment, Groups I-IV still lack unity for the following reasons. Groups I-III are not linked by the special technical feature of a cross-linked animal glue as Group I does not require cross-linked animal glue. Thus, the special technical feature remains animal glue which feature is not a contribution over the prior art in view of Mallik such that lack of unity remains between Groups I-III. Further, to the extent that it could be argued that Groups I and IV have the same or corresponding special technical of an activator including cross-linking agent Heise et al. (U.S. Patent 2,805,172) teaches an activator including cross-linking agent such that

the feature is not a contribution over the prior art and lack of unity remains between Groups I and IV.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mallik (U.S. Patent Application Publication 2003/0102080) in view of Heise et al. (U.S. Patent 2,805,172).

Mallik discloses a method for applying a polymeric label of for example polyester to a container of for example glass. Mallik teaches the method comprises applying a layer of animal glue and water to a polymeric label, drying the layer to form a solid, water activatable animal glue layer, applying a sufficient amount of water to activate the animal glue, and fastening the label to a container by drying the water activated layer of animal glue (Figures 1 and 2 and Paragraphs 0013, 0018, and 0020-0023).

Regarding the limitations of “a hydrophilic solid material”, “a tacky fastenable adhesive”, and “curing the polymeric label”, the material, i.e. animal glue, and method, i.e. applying the animal glue with water, drying, activating with water, applying, and drying, taught by Mallik is consistent and in agreement with that claimed and disclosed in applicants

specification as a hydrophilic solid material that forms a tacky fastenable adhesive when activated with water and cures by drying to fasten the label to the container such that the method taught by Mallik is considered to intrinsically result in the same.

Regarding the limitation of “water containing a cross-linking agent or a water based adhesive containing a cross-linking agent”, Mallik is silent to using any particular animal glue or water activator. However, it was known in the art that the animal glue include an alkaline salt, e.g. 90 dry parts animal glue and 10 dry parts alkaline salt, and the water activator include glyoxal, a cross-linking agent, and an acid or acid salt such that the animal glue will form a water resistant bond between a label and a substrate such as a bottle as shown by Heise (Column 1, lines 15-13 and Column 3, lines 8-20 and Example II). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the animal glue and water activator taught by Mallik the specific animal glue and water activator shown by Heise to form a water resistant bond between the label and the container. Regarding claim 8, water, cross-linking agent, and an acid or acid salt is considered a water based activator containing an effective amount of a cross-linking agent.

Regarding claim 9, Mallik and Heise are silent as to the specific amount of animal glue applied. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine the amount of animal glue required in Mallik as modified by Heise as a function of achieving an adequate bond between the label and container wherein because the material and method taught by Mallik as modified by Heise is consistent and in agreement with that disclosed by applicant and both result in an adequate bond one of ordinary skill would readily expect to use the same in Mallik as modified

by Heise as claimed. It is noted that applicants specification discloses 0.25 to 8 lbs./3000 square feet is employed (Page 24, lines 15-21), and the claimed range is 120 to 4300 lbs./3000 square feet such that it appears the claimed range may be in error. Further, the specification does not show any unexpected result for either of the ranges of amounts other than these amounts result in an adequate bond.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mallik and Heise as applied to claims 1-3, 5, 6, 8, and 9 above, and further in view of Dronzek (U.S. Patent Application Publication 2001/0035265).

Mallik and Heise teach all of the limitations in claim 10 as applied above except for a specific teaching of including a slip aid with the animal glue. It was known in the art of using water activated adhesive that the adhesive include a slip aid to prevent excessive friction between the adhesive and label as shown by Dronzek (Paragraph 0045). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the animal glue taught by Mallik as modified by Heise a slip as shown by Dronzek to prevent excessive friction between the glue and the label.

5. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mallik (U.S. Patent Application Publication 2003/0102080) in view of Leiner et al. (U.S. Patent 2,985,605).

Mallik discloses a method for applying a polymeric label to a container of for example glass. Mallik teaches the method comprises applying a layer of animal glue and water to a polymeric label stock, and fastening the label to a container by drying the water activated layer of animal glue (Figures 1 and 2 and Paragraphs 0013, 0018, and 0020-0023).

Regarding the limitations of “a layer of an hydrophilic solid material”, the material, i.e. animal glue, and method, i.e. applying the animal glue with water and drying, taught by Mallik is consistent and in agreement with that claimed and disclosed in applicants specification as resulting in a layer of a hydrophilic solid material such that the method taught by Mallik is considered to intrinsically result in the same.

Regarding the limitation of “a aqueous dispersion comprising animal glue containing a cross-linking agent”, Mallik is silent to disclosing any particular animal glue. However, it was known in the art that the animal glue include trimethylolphenol, a cross-linking agent, e.g. at least 30% by dry weight animal glue, such that the animal glue will form a water resistant bond as shown by Leiner (Column 3, lines 7-10, 42-49, and 61-69 and Example I). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the animal glue and water activator taught by Mallik the specific animal glue and water activator shown by Heise to form a water resistant bond between the label and the container. Regarding claim 13, Heise further teaches including silicates, a slip agent.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 11 and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,517,664 in view of Leiner. Claims 1-29 of U.S. Patent No. 6,517,664 fully encompass claims 11 and 13 of the instant application except for a teaching of the water based adhesive comprising at least 30% by dry weight of animal glue in which it is obvious to use the animal glue taught by Leiner more fully described above to form a water resistant bond.
8. Claims 1-3, 5, 6, and 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,090,740 in view of Heise. Claims 1-4 of U.S. Patent No. 7,090,740 fully encompass claims 1-3, 5, 6, and 8-10 of the instant application except for a teaching of the water activatable fastening layer comprising at least 30% by dry weight of animal glue in which it is obvious to use the water activatable animal glue taught by Heise more fully described above to form a water resistant bond. Claim 3 is further rejected in view of Mallik as it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the polymeric label that known as suitable in the art such as polyester as shown by Mallik. Claim 10 is further rejected in view of Dronzek as it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the animal glue a slip as shown by Dronzek to prevent excessive friction between the glue and the label.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571)272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/
Primary Examiner, Art Unit 1791